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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/264,171	03/05/1999	LESLIE STROH	STROH	2689
545	7590	03/10/2006	EXAMINER	
ROGER PITT KIRKPATRICK & LOCKHART NICHOLSON GRAHAM LLP 599 LEXINGTON AVENUE 33RD FLOOR NEW YORK, NY 10022-6030			COLBERT, ELLA	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 03/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/264,171	Applicant(s) STROH, LESLIE	
	Examiner Ella Colbert	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-80 and 92-101 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 35-80 and 92-101 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 35-80 and 92-101 are pending. Claims 44, 64, and 68 have been amended in this communication filed 12/27/05 entered as Response to Election/Restriction and Request for Extension of Time.
2. The Applicant's amendments have not overcome the Restriction in the Requirement for Restriction/Election of 10/17/05. The Restriction still remains as set forth and for the reasons here below.
3. The requested references that could be found have been received and reviewed.

Election/Restrictions

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 35-43 and 92-98, drawn to a method of providing an event-activated prerelease latent payment draft, classified in class 705, subclass 45.
 - II. Claims 44-67, and 99, drawn to a method for providing an event-activated first bill-of-exchange, classified in class 705, subclass 1.
 - III. Claims 68-80, 100, and 101, drawn to a computer-assisted trade finance method for financing the sale of a traded product, a computer-assisted method for trading a product, and a computer-implemented method for electronically facilitating a trade transaction including a pro-forma invoice identifying the buyer and the seller and having indicia indicating the traded

product and the executed pro-forma invoice having information describing a commercial transaction, classified in class 705, subclass 37.

5. Inventions Group I, Group II and Group III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Group I has a method of providing an event-activated latent payment draft and Group II has a method for providing an event-activated first bill-of-exchange. The subcombination Group III has separate utility such as a computer-assisted trade finance method for financing the sale of a traded product, a computer-assisted method for trading a product, and a computer-implemented method for electronically facilitating a trade transaction including a pro-forma invoice identifying the buyer and the seller and having indicia indicating the traded product and the executed pro-forma invoice having information describing a commercial transaction.

In the instant case, invention Group I has separate utility such as the buyer providing an event –activated prerelease latent payment draft, the buyer accepting the payment draft, the buyer and seller commencing a payment term, and the seller releasing the traded product. Group I can be used in another environment such as in the shipping industry where the buyer is provided a prerelease bill of latent and the seller releasing the product(s). Invention Group II has separate utility such as providing

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an event-activated prerelease first bill-of exchange to the seller or the seller's agent, and the buyer executing a second bill-of exchange and Group III has separate utility such as financing the sale of a traded product, a pro-forma invoice indicating the identities of the buyer and the seller, trading a product, and electronically facilitating a trade transaction including a pro-forma invoice identifying the buyer and the seller and having indicia indicating the traded product and the executed pro-forma invoice having information describing a commercial transaction. Group II can be used in another environment such as where a bill-of-exchange is used with the buyer accepting the conditions of the bill-of-exchange for the product or merchandise. Group III can be used in another environment such as buying and selling any product or merchandise where an invoice is used to request payment of the product(s) or merchandise or service(s). See MPEP § 806.05(d).

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination as indicated is proper.

7. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II and Group III and the search for Group II is not required for Group I and Group III, and the search for Group III is not required for Group I and Group II, restriction for examination purposes as indicated is proper.

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8. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

9. Applicant is advised that the reply to this requirement to be completed must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Response to Arguments

10. Applicant's arguments filed 08/05/05 and the arguments filed 12/27/05 have been fully considered.

Issue no. 1: Applicant Argues: because of difficulties in understanding the election requirement, as explained previously, identification of every claim reading on a given "species" has not been found practicable and it is respectfully requested that this requirement also be withdrawn or be further explained so that Applicants' can comply with the same without undue difficulty has been considered. The Election of species has been withdrawn and a new clear restriction has been given. Applicants' are reminded to withdraw any claims in the non-elected invention whether the election be with or without traverse and a set of claims be submitted identifying the "withdrawn" or "previously amended" or "presently amended" or "cancelled" claims.

Issue no. 2 (12/27/05): Applicant argues: The bill-of-exchange or first bill-of-exchange recited in independent claims 44, 64, 68, 75, and 101 is an embodiment of the payment draft defined in claim 35 and claims 44, 64, 68, 75, and 101 have been made coterminous with base claim 35 with respect to the recitation of the bill of

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exchange as being event-activated, prerelease and latent has been considered but is not persuasive. Response: The recitation of “the bill of exchange as being event-activated, prerelease and latent” are not the only recitations that make the claims distinct and restrictable. Where is the latent payment draft and the pro forma invoice in the independent claims 44 and 64 in Group II? Where is the latent payment draft in the independent claims 68, 75, 100, and 101 in Group III? Where is the first bill-of – exchange and second bill-of –exchange and the proforma invoice in independent claim 35 in Group I?

These are the reasons for the restriction requirement still remaining.

Inquiries

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Tuesday-Thursday, 6:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



E. Colbert
Primary Examiner
February 27, 2006